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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/723,370   | 11/26/2003  | John N. Gross        | JNG 98001C          | 8022             |
| 23694  | 7590        | 11/25/2008           | EXAMINER            |                  |
| J. NICHOLAS GROSS, ATTORNEY<br>2030 ADDISON ST.<br>SUITE 610<br>BERKELEY, CA 94704 |             |                      | SPOONER, LAMONT M   |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2626                |                  |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/723,370             | GROSS ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | LAMONT M. SPOONER      | 2626                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 June 2008.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 83-103 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 83-103 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 26 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Introduction***

1. This office action is in response to applicant's appeal brief filed 6/9/08. Claims 83-103 are currently pending and have been examined.
2. In view of the appeal brief filed on 3/7/05, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted.

See 37 CFR 1.193(b)(2).

### ***Response to Arguments***

3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). More specifically, on pages 22 and 23, applicant argues, “This statement is completely unsupported by the section of Russell-Falla above cited by the Examiner. The citation mentions setting a threshold on a browser, not on the web page in question. The reference makes no mention of these being thresholds being used by an author of an email message; they are thresholds being used by a web surfer looking at web pages.” The Examiner never cites “email” from Russell-Falla, or “thresholds being used by an author of an email message”, the Examiner relies on Russell-Falla simply for “an author is alerted only if a sensitive threshold specified by the author is exceeded” (C.5 lines 34-51- his “means for a parent, guardian or other administrator to set up one or more user accounts and select appropriate threshold values for each user”, abstract-his offensive content, and statistical analysis, C.1 lines 10-15, his scanning of emails, Russell-Falla explicitly states, “Of course the invention is fully applicable to digital records or datasets other than web pages, for example files, directories and email messages”, Russell-Falla C.3 lines 17-22, thus further rendering applicant's arguments that Russell-Falla is only applicable to a “web

page"). It is the setting of the threshold that the Examiner has extracted from Russell-Falla. However, it is evidenced by Russell-Falla that an email may be rated according to a sensitivity threshold, see above cited sections as applied to email, and also C.9 lines 4-22, his email, weights and rating of the email.

4. In response to applicant's arguments, page 17, " Applicant submits that it could not be clearer that Bradshaw does NOT permit authors to bypass the security/blocking software. As explained at col. 9, II. 1 - 5, when users/authors attempt to circumvent the blocking routine, they are left with "...two choices (1) to call a supervisor to disable the system with a password or (2) reboot the computer .... ""

The Examiner notes in Bradshaw, C.2 lines 57-67-screen production of email, C.3 lines 10-34, C.4 lines 18-21, Bradshaw explicitly teaches giving screening of content of a user, libraries, and content for sending by a user, the Examiner notes that the actual blocking mechanism that prevents the mail from being sent is known by a supervisor, in the form of a password, C.8 lines 59-61, however, the Examiner notes a user can be a supervisor, C.5 lines 32-34, explicitly detail the supervisor as "anyone who has authority to control the user of the computer system in which X-Stop is

installed." Thus, there is nothing to prevent a Supervisor from creating a message, and having the message dynamically scanned and prompted for vulgar language, blocked from transmission, entering the password, (editing or not the content) and sending the message through his email application, as X-stop is running on the application. Therefore all applicant's arguments as to who a supervisor not being permitted to be an author are unpersuasive.

5. Applicant's remaining arguments with respect to claims 83-103 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 96-103 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 96-103 merely cite functional descriptive material, computer program per se, without any embodiment. A claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of

the computer which permits the computer program's functionality to be realized, and is thus statutory (see MPEP 2106).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 83, 84, 87, 92, 94, 96, 100 and 101 are rejected under 35 U.S.C. 102(e) as being anticipated by Bradshaw (US 5,835,722).

As per **claim 83**, Bradshaw teaches a method of permitting an author of an electronic mail (email) message to check text content using an electronic text editor program operating on a computing system, the method comprising:

(a) selecting a language filter for checking words in the email message (C.7 lines 18-26-his foul language filter), which language filter includes a first set of words that could be offensive and/or potentially

inappropriate for use in connection with an intended recipient of the email message (ibid, his library of foul language); and

- (b) receiving input words entered by the author as text for the email message (C.8 lines 35-37-his author typing the words);
- (c) inspecting said input words to determine if they fall within said language filter (C.8 lines 35-40-his inspection of the words and comparison to his libraries);
- (d) alerting the author when one or more of said input words fall within said language filter (C.8 lines 54-58, his blocking screen);
- (e) permitting the author to change words within the email message after step (d) and before the email message is transmitted to said intended recipient (C.8 lines 55-59-his typed password, thus allowing access to the email, at this point there is no transmission, and C.4 lines 25-28-his text editor, wherein it is inherent that the author with access in a text editor, can make changes); and

wherein the author of the email message can cause the email message be transmitted by the computing system to said intended recipient even if the words in such email message still fall within said language filter (C.2 lines 57-67-screen production of email, C.3 lines 10-34, C.4 lines 18-

21, Bradshaw explicitly teaches giving screening of content of a user, libraries, and content for sending by a user, the Examiner notes that the actual blocking mechanism that prevents the mail from being sent is known by a supervisor, in the form of a password, C.8 lines 59-61, however, the Examiner notes a user can be a supervisor, C.5 lines 32-34, explicitly detail the supervisor as “anyone who has authority to control the user of the computer system in which X-Stop is installed.” Thus, there is nothing to prevent a Supervisor from creating a message, and having the message dynamically scanned and prompted for vulgar language, blocked from transmission, entering the password, (editing or not the content) and sending the message through his email application, as X-stop is running on the application.

As per **claim 84**, Bradshaw teaches claim 83. Bradshaw further teaches wherein said language filter includes obscene, vulgar and/or racist words found in a first pre-programmed dictionary created without input from the author (C.3 lines 30, 31-library, C.6 lines 9-14-his third library, see Fig. 2-his stored library).

As per **claim 87**, Bradshaw teaches claim 83. Bradshaw further teaches a step (f): checking one or more additional electronic message files

according to steps (a) through (d) (C.2 lines 61-67-his documents, C.5 lines 35-40-his transmission of the any messages/data).

As per **claim 92**, Bradshaw teaches claim 83. Bradshaw further teaches wherein steps (a) through (e) are implemented as a software routine in a machine readable form executable by a personal computer (Bradshaw, C.5.lines 3-25).

As per **claims 94, 100 and 101**, claims 94, 100 and 101, set forth limitations similar to claim 83, and are thus rejected for the same reasons and under the same rationale.

Bradshaw further teaches inspecting said input word substantially immediate in time after it is entered to determine if it falls within said language filter, and wherein said input word is checked before the author has entered another input word (C.8 lines 35-60-as the user types, X-Stop monitors and checks the content of each character, claims 94, 100 and 101).

As per **claim 96**, Bradshaw teaches a computer program for checking text content of an email message using an electronic text editor program operating on a computing system (C.5 lines 25, 26-his software), comprising:

a language filter for checking words in the email message (C.7 lines 18-26-his foul language filter), which language filter is an electronic dictionary which includes a set of words that could be offensive and/or potentially inappropriate for use in connection with an intended recipient of the email message (ibid, his library of foul language); and a content checking routine which is adapted for:

- i) receiving input words entered by the author as text for the email message (C.8 lines 35-37-his author typing the words);
- ii) inspecting said input words to determine if they fall within said language filter (C.8 lines 35-40-his inspection of the words and comparison to his libraries);
- iii) generating an alert to the author when ea one or more of said input words fall within said language filter (C.8 lines 54-58, his blocking screen);
- iv) permitting the author to change words within the email message after an alert is generated and before the email message is transmitted to said intended recipient (C.8 lines 55-59-his typed password, thus allowing access to the email, at this point there is no transmission , and C.4 lines

25-28-his text editor, wherein it is inherent that the author with access in a text editor, can make changes); and

wherein the author of the email message can cause the email message to be transmitted by the computing system to said intended recipient even if words in such email message still fall within said language filter (C.2 lines 57-67-screen production of email, C.3 lines 10-34, C.4 lines 18-21, Bradshaw explicitly teaches giving screening of content of a user, libraries, and content for sending by a user, the Examiner notes that the actual blocking mechanism that prevents the mail from being sent is known by a supervisor, in the form of a password, C.8 lines 59-61, however, the Examiner notes a user can be a supervisor, C.5 lines 32-34, explicitly detail the supervisor as “anyone who has authority to control the user of the computer system in which X-Stop is installed.” Thus, there is nothing to prevent a Supervisor from creating a message, and having the message dynamically scanned and prompted for vulgar language, blocked from transmission, entering the password, (editing or not the content) and sending the message through his email application, as X-stop is running on the application).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 85 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw et al. (Bradshaw, US 5,835,722) in view of Cohen (US 5,796,948).

As per **claim 85**, Bradshaw teaches the method of claim 83, but lacks providing a highlighting of any words which are determined to fall within said language filter along with an accompanying visual warning. However, Cohen teaches providing a highlighting of any words which are determined to fall within said language filter along with an accompanying visual warning (C.4.lines 30-50-his bracketing of each profanity, and profanity message displayed to the user). Therefore, at the time of the invention, it would have been obvious to one ordinarily skilled in the art to modify Bradshaw's warning display with Cohen's highlighting of words, providing the benefit of identifying words falling within the language filter.

As per **claim 86**, Bradshaw teaches claim 83. Bradshaw lacks explicitly teaching identifying a language filter to the author which was triggered during step (d). However, Cohen teaches identifying a language filter to the author which was triggered during step (d) (C.4.lines 36-38-his profanity message). Therefore, at the time of the invention, it would have been obvious to one ordinarily skilled in the art to modify Bradshaw with Cohen's profanity message, providing the benefit of identifying the language filter.

12. Claims 88, 89 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw, as applied to claim 83 above, and further in view of Stamps et al. (Stamps, US 5,437,036).

As per **claims 88 and 89**, Bradshaw teaches claim 83, but lacks including a step (f): checking spelling of the email message, and further lack wherein said language filter includes a second dictionary with foreign language words.

However, Stamps teaches checking spelling (C.3.lines 17-30-his spell checking), and a dictionary with foreign language words (C.3 lines 31-44-his various language dictionaries), which second dictionary is part of a second electronic file which is separate from a first electronic file used for

said first set of words and can be considered separately from said first electronic file (ibid, his each dictionary). Therefore, at the time of the invention, it would have been obvious to modify Bradshaw's email message (document) with spell checking and language filter for foreign language words. The motivation for doing so would have been to have correct spelling and improper foreign language words.

As per **claim 97**, Bradshaw teaches claim 96, and further teaches wherein said language filter includes at least a first dictionary and a second separate dictionary (Fig. 2 his libraries), but lacks said alert includes an indication of which of said first dictionary or said second dictionary was triggered by said alert.

However, Stamps teaches said language filter includes at least a first dictionary and a second separate dictionary, and said alert includes an indication of which of said first dictionary or said second dictionary was triggered by said alert (C.3 lines 31-44-his various language dictionaries, C.4 lines 5-16 and C.5 lines 63-67-his specified dictionaries). Therefore, at the time of the invention, it would have been obvious to modify Bradshaw's libraries dictionary with two independent dictionaries. The motivation for

doing so would have been identify the dictionary for the correction (Stamps, ibid).

13. Claims 90, 91, 93, 98 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw, as applied to claim 83 above, and further in view of Russell-Falla et al. (Russell-Falla, US 6,675,162).

As per **claims 90 and 91**, Bradshaw teaches claim 83, but lacks teaching wherein an author is alerted during step (d) only if a sensitivity threshold specified by the author is exceeded, and wherein said sensitivity threshold is specified as a numerical value ranging from 1 to 10.

However, Russell-Falla teaches wherein an author is alerted only if a sensitivity threshold specified by the author is exceeded (C.5.lines 34-51, abstract). The Examiner takes Official notice that a sensitivity threshold can have a range of numerical values. Therefore, at the time of the invention, it would have been obvious to modify Bradshaw's language filter with a threshold specified by an author, wherein the threshold has a range (such as 1-10). The motivation for doing so would have to allow user designate a threshold to filter content (Russel-Falla, abstract).

As per **claims 93 and 98**, claims 93 and 98 set forth limitations similar to claim 83 and 91, and are thus rejected for the same reasons and under the same rationale.

As per **claim 99**, Bradshaw and Russell-Falla make obvious claim 98, Russell-Falla also teaches wherein said sensitivity threshold is used during a check of individual words in said language filter (C.5.lines 65-67, abstract-his email).

14. Claims 95, and 102, and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw in view of Rayson et al. (Rayson, US 5,761,689).

As per **claims 95, 102, and 103**, claims 95, and 102, set forth limitations similar to claim 83, and are thus rejected for the same reasons and under the same rationale.

Bradshaw lacks inspecting said input words during idle periods when the author is not interacting with said electronic text editor program to determine if such input words fall within said language filter and said inut words are also checked for spelling during said idle periods (claims 95, 102 and 103).

However, Rayson teaches inspecting said input words during idle periods when the author is not interacting with said electronic text editor program (C.2.lines 12-24-his automatic as immediate and delimiting as before the user enters another word, C.3.lines 24-31-as his spell check, and language filtered as misspellings are interpreted as inappropriate for use in connection with an intended recipient of an email message-claims 102, 103). Therefore, at the time of the invention, it would have been obvious to modify Bradshaw's language filter with after an idle period scan of the words to be filtered. The motivation for doing so would have been to automatically scan an entry either immediately as input or after an idle period, for correction (ibid, Rayson-C.3 lines 24-30, abstract and summary).

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAMONT M. SPOONER whose telephone number is (571)272-7613. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571/272-7603.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ims  
11/08/08

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